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EXAMINER

LEWIS, KIM M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 10/22/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,403

Applicant(s)

TEBBE, GEROLD

Examiner

Kim M. Lewis

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/2/63.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 14-19 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action

DETAILED ACTION

Response to Amendment

The amendment filed on 5/27/03 has been received and made of record in the application file wrapper. Claims 1 and 15 have been amended as requested.

Allowable Subject Matter

The indicated allowability of claim 3, which has been deleted, and the subject matter added to independent claim 1, is withdrawn. Additionally, the indicated allowability of claims 16-18 is withdrawn. Prosecution on this application has been reopened. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards claim 18, the claim is indefinite in that the examiner is unclear as to which dimension of the backing the applicant is claiming. Since claim 18, depends from claim 10, the examiner will assume that the dimension being claimed is thickness. However, clarification is requested.

Claim Rejections - 35 USC § 102

Claims 1, 2, 4 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,120,325 ("Dow, Jr.").

As regards claim 1, Dow, Jr. substantially discloses all features of the claim including a backing layer having top and bottom sides, a working layer (absorbent pad), an adhesive layer applied to the bottom side of the backing layer, and a non-toxic pigmented composition coated onto or embedded into said top side of said backing layer (col. 2, lines 10-21). Dow, Jr. further teaches that the backing layer includes a surface treatment in the form of perforations to make it porous and breathable (*i.e.*, hydrophilic).

As regards claims 2 and 4, and the rough external surface, note the disclosure of the folds and grooves to simulate the texture of human skin (col. 2, lines 40-44).

As regards claim 15, it is inherent in the disclosure of Dow, Jr. that the adhesive is constantly tacky. Additionally, Dow, Jr. discloses at col. 2, lines 63-66 that a peelable protective layer can be applied to the adhesive layer to prevent premature adhesion of the bandage. This protective layer reads on the backing layer of the present invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of U.S. Patent No. 3,797,494 ("Zaffaroni").

As regards claims 5 and 6, Dow, Jr. fails to teach that the absorbent layer (working layer) comprises at least one microencapsulated active substance. However, Zaffaroni discloses a bandage comprising a working layer (12) having uniformly distributed therein, microcapsules (13) comprising a drug (e.g., pharmaceuticals acting on the skin such as bacitracin and hydrocortisone) encapsulated with a microporous rate controlling material for the continuous administration of drugs to the skin or mucosa (abstract and col. 9, lines 54-66).

In view of Zaffaroni, it would have been obvious to one having ordinary skill in the art to modify the absorbent pad (working layer) of Dow, Jr. with the addition of microcapsules comprising a drug (e.g., encapsulated with a microporous rate controlling material for the continuous administration of drugs to the skin or mucosa).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow Jr. in view of U.S. Patent No. 2,905,174 ("Smith").

Art Unit: 3761

As regards claim 7, Dow, Jr. discloses the backing as having a flesh colored surface so as to conceal the wound dressing. Dow, Jr. is deficient in disclosing the base layer as bearing a printing-ink layer. However, Smith teaches an adhesive bandage with a transparent film backing, in which the backing is provided with a series of cosmetic preparations in the form of flesh-colored markings (printing-ink layer) (col. 1, line 65-col. 2, line 29 and col. 4, lines 51-56) for the purpose of rendering the bandage less noticeable.

It would have been obvious to substitute the means for reducing the noticability of a wound dressing, e.g., the melanin-like pigment composition, disclosed by Dow, Jr. for another means for reducing the noticability of a wound dressing, e.g., the flesh-colored marking (printing-ink layer) as taught by Smith, since both means conceal an/or render the bandage less noticeable.

As regards claim 8, Smith discloses that the printing-ink layer is between the transparent backing and the adhesive layer (col. 4, lines 57-60). When the bandage of Doe, Jr. is modified to contain the printing ink layer, it too will have the printing-ink layer is between the backing and the adhesive layer.

Additionally, Dow, Jr. fails to teach a transparent backing; however, Smith teaches a transparent backing. One having ordinary skill in the art would be motivated to construct the backing layer from transparent material, as taught by Smith, in order to allow the bandage to blend into the skin.

Art Unit: 3761

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of U.S. Patent No. 4,702,237 ("Gianopoulos et al.")

As regards claim 9, Dow, Jr. fails to teach the backing layer is constructed from rubber. However, Dow, Jr. discloses at col. 2, lines 29-34 that the backing can be any inert flexible material..., or any other natural or synthetic polymer or fiber or any combination thereof.

Gianopoulos et al. teach it is conventional to construct bandages with latex rubber backing layers because latex rubber is flexible yet strong and does not irritate the skin.

In view of Gianopoulos et al., it would have been obvious to one having ordinary skill in the art to construct the bandage of Dow, Jr. with a latex rubber backing because latex rubber is flexible yet strong and does not irritate the skin.

Additionally, the examiner wishes the applicant to note that it has been held that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227, F.2d 197, 125 USPQ 416 (CCPA 1960).

Claims 10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr.

As regards claim 10, Dow, Jr. fails to teach that the thickness of base layer amounts to between 20 and 100 μm , preferably 30 to 60 μm . Absent a critical teaching and/or a showing of unexpected results derived from providing the thickness of the

Art Unit: 3761

backing layer in an amount between 20 and 100 μm , preferably 30 to 60 μm , the examiner contends that the thickness of the backing layer is an obvious design choice which does not patentably distinguish applicant's invention.

Additionally, the examiner further contends that one having ordinary skill would have been motivated to provide a thin backing layer in order to the backing layer inconspicuous.

As regards claims 16 and 18, Dow, Jr. fails to teach drying agents in the form of kieselguhr and aluminum oxide, and skin care products in the form of soothing oils. Absent a critical teaching and/or a showing of unexpected results derived from providing the working layer with drying agents in the form of kieselguhr and aluminum oxide, and skin care products in the form of soothing oils, the examiner contends that the addition of any active substance to the bandage of Dow, Jr. is an obvious design choice, which does not patentably distinguish applicant's invention.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of U.S. Patent No. 4,618,519 ("Koch et al.").

As regards claim 11, Dow, Jr. fails to teach a curable adhesive. However, Koch et al. teach it is conventional to provide adhesive articles with a curable adhesive that cures at ambient temperature such that the article can cure *in situ* (abstract).

In view of Koch et al., it would have been obvious to one having ordinary skill in the art to modify Dow, Jr. by substituting the disclosed adhesive for a curable adhesive

Art Unit: 3761

so that the bandage can cure in situ. This will allow proper placement of the article without premature adhesion of the article to an unwanted area on the skin.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of U.S. Patent No. 4,807,753 ("Goldstein").

Regarding claim 14, Dow, Jr. substantially discloses all features of the claim except a set comprising a plurality of bandages of various sizes. However, Goldstein teaches it is conventional in the art to provide a set comprising a plurality of bandages in order to fit various sized wounds.

In view of Goldstein, it would have been obvious to one having ordinary skill in the art provide the bandages of Dow, Jr. in a set comprising various sizes in order to fit various sized wounds.

As to the bandage being punched out of a planar material, the applicant should note that in a product claim, the method by which the product is formed is a non-distinctive characteristic, which does not serve to distinguish.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays to Wednesdays from 5:30 am to 4:00 pm.

Art Unit: 3761

The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.3590 for regular communications and 703.305.3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0858.

A handwritten signature in black ink, appearing to read 'Kim M. Lewis', with a long horizontal stroke extending to the right.

Kim M. Lewis
Primary Examiner
Art Unit 3761

kml
October 19, 2003